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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,377

07/06/2005

Valerie Autier

MERCK-3028

8732

23599

7590

10/24/2008

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EXAMINER

HUGHES, ALICIA R

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

10/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/541,377

Applicant(s)

AUTIER ET AL.

Examiner

ALICIA R. HUGHES

Art Unit

1614

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 29 September 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 16, 27-28, and 30-46.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Raymond J Henley III/
Primary Examiner, Art Unit 1614

Continuation of 3. NOTE: Applicants, in their response of 21 August 2008, amended the claims and the specification in a manner that broadened the scope of the claims by adding a compound that was not listed previously in either the specification or the claims. The result of the addition is support for a written description rejection under 35 U.S.C. 112, first paragraph for new matter.

Continuation of 11. does NOT place the application in condition for allowance because: Giordani et al serves as prior art against the instant claims, because the reference teaches a class of 4-phenyl-4-oxobutanoic acid derivatives and their pharmaceutically acceptable salts (Abstract) with a core structure that encompasses the core structure of the present invention useful in the treatment of glaucoma/retinopathy (Col. 3, lines 4-20). Giordani et al also teach that the 4-phenyl-4-oxobutanoic acid derivatives are used as a kynurenine-3-hydroxylase inhibitor (Col. 3, lines 4-5). It is well understood in the art that retinopathy is a known complication associated with diabetes.

More specifically, the prior art makes obvious the instant invention in that in the present invention, R1 may represent a heterocyclic radical, which could be identical to the phenyl ring disclosed in Giordani et al. The present invention's R2 is the equivalent of Giordani's R2, and the present invention's R3 is the equivalent of Giordani's R4. According to Giordani, both its R2 and R4, just as its R3 and R1, can be hydrogen, halogen, thiol, alkenyl, alkoxy, etc., just as the present invention's R2 and R3 positions can be the same. The present invention's W represents a divalent radical which is the equivalent to the cycloalkyl formed in Giordani et al that includes R1 and R3, and finally, R4 in the present invention, which is the equivalent of R in Giordani et al, can both be, for example, a heterocyclic ring or an alkenyl or alkyl. In light of the foregoing, a method of treating diabetes and associated complications by the administration of a 4-phenyl-4-oxobutanoic acid derivatives used as a kynurenine-3-hydroxylase inhibitor is obvious in view of Giordani et al.